

## REMARKS

This amendment is submitted in response to the non-final Office Action mailed on January 24, 2005. Claims 1-6, 8-10 and 12-32 are pending in this application. Claims 7 and 11 have been cancelled previously. In the Office Action, Claims 1-6, 8-10 and 12-32 are rejected under 35 U.S.C. §103. In view of the response set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1-6, 8-10, 12-17 and 23-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,258,197 to Wheeler et al. ("Wheeler"). Claims 18-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Wheeler* in view of U.S. Patent No. 5,192,262 to Grey et al. ("Grey"). Applicants believe these rejections are improper and respectfully traverse them for at least the reasons set forth below.

Regarding the obviousness rejection over *Wheeler*, the Patent Office alleges that *Wheeler* discloses a chewing gum containing a plasticizer which can be a structured triacylglycerol prepared by esterfying triacetin, tripalmitin with various long chain fatty acid sources and that the disclosed triacylglycerols can partially or fully replace the synthetic or natural fat in chewing gum. Applicant respectfully requests that rejection be reconsidered and withdrawn for the following reasons.

Independent Claim 1 recites a gum base comprising an elastomer and about 0.02% to about 40% by weight structured triacylglycerols that include short and long chain acyl triglyceride molecules. Independent Claim 9 recites a chewing gum formulation comprising an insoluble gum base; a water soluble portion; a flavor; and about 0.01% to about 10% by weight structured triacylglycerols that include short and long chain acyl triglyceride molecules. Independent Claim 23 recites a gum base comprising polyvinyl acetate; an elastomer; and about 0.02% to about 40% by weight structured triacylglycerols that include short and long chain acyl triglyceride molecules. Independent Claim 31 recites a chewing gum formulation comprising an insoluble gum base including polyvinyl acetate and an elastomer; a water soluble portion; a flavor; and about 0.01% to about 10% by weight structured triacylglycerols that include short and long chain acyl triglyceride molecules. In contrast, Applicants respectfully submits that the obviousness rejection with respect to *Wheeler* fails: (1) because it is based on a hindsight

recreation of Applicants' present claims; and (2) a plethora of claim elements are still not disclosed nor suggested by *Wheeler*.

The Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Further, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Applicants respectfully submit that the Patent Office's obviousness rejection under *Wheeler* is an improper hindsight recreation of Applicants' present claims. For example, other than *Wheeler*'s passing reference to the use of its reduced calorie triglyceride mixtures in gum at Column 14, line 29 and Column 13, line 50, *Wheeler* contains no other disclosure relating to the use of its triacylglycerides in gum. *Wheeler* neither provides motivation that would lead one of skill in the art to incorporate any specific or optimal quantity of its triglycerides to produce a suitable gum formulation or gum product, nor provides any disclosure or guidance as to how gum products incorporating *Wheeler* triacylglycerides could be produced according to the present claims. Thus, *Wheeler* itself does not contain a sufficient teaching or direction of how to obtain the desired chewing gum composition. Instead, the Patent Office has improperly used Applicants' own disclosure as guidance for showing how to produce a gum having triacylglycerols that include short and long chain acyl triglyceride molecules according to the present claims.

In addition, Applicants respectfully submit that *Wheeler* fails to disclose or suggest a number of elements of the present claims. With respect to independent Claims 1 and 23, *Wheeler* fails to disclose or suggest gum bases containing an elastomer or about 0.02% to about 40% by weight of the structured triacylglycerols that include short and long chain acyl triglyceride molecules. With respect to Claims 9 and 31 *Wheeler* fails to disclose or suggest gum

formulations containing an insoluble gum base, a water soluble portion, a flavor or about 0.01% to about 10% by weight of the structured triacylglycerols that include short and long chain triacylglyceride molecules. Numerous elements of the dependent claims are also not disclosed in *Wheeler* (e.g. wax-free base, resin, softeners, emulsifiers, etc.). Further, the Patent Office has failed to provide any support in *Wheeler* showing these elements of the present claims. Instead, the Patent Office takes the easy route of improperly concluding that these recited elements are all obvious without providing further support from any particular source. However, a statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” is not sufficient by itself to establish *prima facie* obviousness. See MPEP 2143.01.

For these reasons, Applicants submit that Claims 1, 9, 23 and 31 are not obvious and are patentable over *Wheeler*. Further, Claims 2-6, 8, 10, 12-17 and 24-30 and 32, which depend from these claims, are nonobvious and patentable at least for the same reasons.

Regarding the obviousness rejection over *Grey* in view of *Wheeler*, the Patent Office alleges that *Grey* describes gum formulations that comprise PVA, fat and elastomers, including triglycerides and lecithin and that *Wheeler* discloses substituting its triacylglycerols for synthetic or natural fat in food products. Applicants respectfully submit that the rejection should be withdrawn for the following reasons.

Independent Claim 18 recites a method for creating chewing gum comprising the step of substituting for a typical plasticizer, softener, or emulsifier in a chewing gum formulation structured triacylglycerols that include short and long chain acyl triglyceride molecules. Independent Claim 21 recites a method for reducing caloric content in a chewing gum formulation including fats/oils comprising the step of substituting structured triacylglycerols that include short and long chain acyl triglyceride molecules in the formulation in a concentration of from about 0.1% to about 10% by weight in place of a portion of the fats/oils.

Applicants submit that in this case the references do not provide the requisite suggestion or motivation to modify *Grey* with the teaching of *Wheeler* in a way that would provide, with any reasonable expectation of success, independent Claims 18 and 21. For example, *Grey* is concerned with a method of manufacturing a chewing gum that involves mixing an amount of a low fat gum base or non-tack gum base having a premix temperature of about 200-240 °F with a

high fat and oil (HFO) gum base having a temperature of about 60-80 °F. See, *Grey*, column 1, lines 31-38. The method is said to result in a more complete incorporation of the HFO gum base in the final gum product. The process results in a product having the desirable nontack properties of HFO gums and the desirable texture, stability, and flavor properties of chewing gums incorporating conventional low fat bases.

Applicants respectfully submit that it is not clear from the references how the *Wheeler* triacylglycerides could be combined with *Grey* such that the advantages described in *Grey* would be obtained. It simply is not clear that the *Wheeler* triacylglycerides could be combined with either an HFO gum base or a low fat gum base or both and the gum bases mixed, as in *Grey*, to obtain a product having *Grey*'s advantages. More specifically, there is nothing to indicate that the *Wheeler* triglycerides could be substituted into the *Grey* HFO gum base component and that, when mixed with the *Grey* low fat gum base, a gum product would be produced that has the desirable nontack properties typical of HFO gums, as in *Grey*. Nor is there any suggestion that the *Wheeler* triglycerides could be substituted into the *Grey* low fat gum base and that, when mixed with the *Grey* HFO gum base, a gum product would be produced that has the desirable texture, stability, and flavor properties typical of low fat gums, as in *Grey*. In fact, replacing the triglycerides of *Grey* with the structured triacylglycerols of *Wheeler* as proposed by the Patent Office would change the desired characteristic of the HFO gum base. Accordingly, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See MPEP 2143.01

In summary, there is nothing in the references to indicate that the advantages in *Grey* would exist if the modifications suggested in the Office action were made. Thus, Applicants submit that there would be no motivation nor any expectation of success in modifying *Grey* with the teaching of *Wheeler*, and therefore the combination is improper.

To support the combination and/or modification of the cited art to arrive at the present claims, the Patent Office has applied hindsight reasoning by selectively piecing together teachings of each of the references in an attempt to recreate what the present claims disclose. Indeed, Applicants respectfully submit that it is only with a hindsight reconstruction of Applicants' present claims that the Patent Office is able to even attempt to piece together a

rejection of the claims. Of course, the Court of Appeals for the Federal Circuit has criticized this motivation to combine analysis (e.g., hindsight reconstruction) because the motivation to combine the references was first disclosed in the present claims. *In re O'Farrell*, 853 F.2d, 894, 902-903 (Fed. Cir. 1988).

For the reasons discussed above, the combination of *Wheeler* in view of *Grey* does not teach, suggest, or even disclose the present claims, and thus, fails to render the claimed subject matter obvious for at least these reasons. Thus, Applicants submit that Claims 18 and 21 and Claims 19-20 and 22 that depend from these claims are patentable over the cited references.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1-6, 8-10 and 12-32 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

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